

### REMARKS

Claims 1-43 remain pending in the present application. New claims 44-50 have been presented. Therefore, claims 1-50 are pending in the present application.

The Examiner rejected claims 1-8, 13-14, 16-18, 20-23, and 38-43 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,773,931 (*Pasady*) and in view of U.S. Patent No. 6,407,396 (*Mih*). Applicants respectfully traverse this rejection.

Applicants respectfully submit that *Pasady* is only available as prior art under 35 U.S.C. 102(e). According to MPEP §706.02(l)(1), "effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention 'were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.' " The present application was filed on or after November 29, 1999. Furthermore, the present application and *Pasady* were, at the time the present invention was made, owned by the same entity or subject to an obligation of assignment to the same entity. Thus, Applicants respectfully submit that *Pasady* is not available as prior art in any obviousness determination. In light of Examiner's own admission that neither *Pasady* nor *Mih* by itself disclose or suggest all of the elements of the claims of the present invention, and since *Pasady* is not available as prior art under 35 U.S.C. 103(a), all of the claims of the present invention are allowable. Applicants respectfully request that the Examiner's rejections of claims 1-8, 13-14, 16-18, 20-23, and 38-43 under 35 U.S.C. 103(a) be withdrawn.

Even if, *arguendo*, *Pasady* and *Mih* were combined, all of the elements of claims of the present invention would not be disclosed or made obvious. *Pasady* is directed to a dynamic

adjustment process of a process target, which is in contrast with the dynamically adjusting metrology of routing based upon correlation of tool state analysis to a batch of workpiece, as called for by claims of the present invention. *Mih* is directed to a metrology system that utilizes a scanning electron microscope for scanning the first pattern through an aperture defined by the inner edges of a photoresist section of a second pattern. When combined, all of the elements of the claims is not taught, disclosed, or suggested.

Also, Examiner has not provided sufficient evidence or arguments to support the requirement when providing an obviousness argument that sufficient motivation is present in the prior art to cause one skilled in the art to modify the prior art to make obvious all of the elements of the claims of the present invention. Those skilled in the art would not be motivated to read upon to combine the disclosures of *Pasadyne* or *Mih* to make obvious the elements of the claimed invention. The Examiner fails to provide sufficient evidence or arguments to support the contrary. The Examiner uses hindsight reasoning to select bits and pieces of various subject matter in an attempt to make obvious all of the elements of the claims of the present invention. Additionally, even if *Pasadyne* and *Mih* were combined, all of the elements of the claimed invention are not taught, disclosed, or suggested by *Pasadyne*, *Mih*, or their combination. *Pasadyne* is directed to dynamic adjustment of a process target. In contrast, *Mih* is directed to the measurement of a first feature in relation to a second pattern being superimposed upon a first feature using metrology data. Those skilled in the art would not combine the dynamic adjustment disclosure of *Pasadyne* with the superimposition of the first feature of *Mih* to teach, disclose, or make obvious all of the elements of the claims of the present invention. Without improper hindsight reasoning, there is absolutely no evidence or suggestion of motivation to

combine such disparate subject matter to make obvious all of the elements of the present invention.

In light of the arguments provided herein, all of the claims of the present invention are allowable. Independent claims 1, 13, 16, 17, 22, 26, 38, 42, 44, and 46 are allowable for at least the reasons cited above. Additionally, dependent claims 2-8, 14, 18, 20-21, 23, 25, 27-33, 39-41, 43, 45, and 47-50 which depend from independent claims 1, 13, 17, 22, 26, 38, and 42, 44, 46, respectively, are also allowable for at least the reasons cited above.

Reconsideration of the present application is respectfully requested.

Applicants acknowledge that the Examiner objected to claims 9-12, 15, 19, 24, and 34-37, as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In light of the arguments presented above, Applicants respectfully assert that claims 1-44 are allowable. In light of the arguments presented above, a Notice of Allowance is respectfully solicited.

If for any reason the Examiner finds the application other than in condition for allowance, **the Examiner is requested to call the undersigned attorney** at the Houston, Texas telephone number (713) 934-4069 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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